

### **SUMMARY OF EXAMINER INTERVIEW**

Applicants would like to thank Examiner Squires for granting an interview on August 4, 2010. Evidence required for swearing behind the primary reference U.S. Patent No. 7,464,041 to Merkin, et al., was discussed. Examiner Squires expressed a willingness to consider an additional Declaration under 37 C.F.R. § 1.131 to establish conception of the invention prior to the effective date of the Merkin reference.

## **REMARKS**

Applicants respectfully request reconsideration of the present Application. Care has been exercised to introduce no new matter. Claims 1-16, 23-46, and 48 are pending and are in condition for allowance.

### **Rejections based on 35 U.S.C. § 103**

#### A. Applicable Authority

Title 35 U.S.C. § 103(a) declares that a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” In *Graham v. John Deere*, the Supreme Court counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. See *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP § 2141.02(I) (emphasis in original) (citing *StratoFlex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” MPEP § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (C.C.P.A. 1970)). Moreover, if an independent claim is nonobvious under 35

U.S.C. 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

“The examiner bears the initial burden of factually supporting a *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness . . . . To reach a proper determination of obviousness, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made. In view of all factual information, the examiner must then determine whether the claimed invention ‘as a whole’ would have been obvious at that time to that person. *Id* (emphasis added). Knowledge of applicant's disclosure must be put aside in reaching this determination . . . . [I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” MPEP § 2142.

“The key to supporting any rejection under 35 U.S.C. 103 is the **clear articulation of the reason(s)** why the claimed invention would have been obvious.” MPEP § 2142 citing *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007) (emphasis added), which notes that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. Moreover, the Federal Circuit has stated that “‘rejections on obviousness **cannot be sustained with mere conclusory statements**; instead, there must be some **articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness.’” MPEP § 2142 (emphasis added) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). See also *KSR*, 127 S. Ct. at 1741 (quoting Federal Circuit statement with approval).

When combining references, “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion

or motivation to make the proposed modification.” MPEP § 2143.01, *citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, each prior art reference “must be considered in its entirety, i.e., as a whole, **including portions that would lead away** from the claimed invention.” MPEP § 2141.02 (citation omitted) (emphasis added).

**B. Rejections Based on Merkin and Dvorak**

Claims 1-7, 15-16, 23-36, and 43-46 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,464,041 to Merkin, et al. (hereinafter the “Merkin reference”) in view of U.S. Publication No. 2003/0208391 to Dvorak, et al. (hereinafter the “Dvorak reference”).

Applicants submit herewith a Declaration under 37 C.F.R. § 1.131 of the coinventors, Jeffrey S. Doyel, D. Allan Shoup, James J. Wagner, and Jennifer A. Ducey. The Declaration includes, as Exhibit A, an expectation management design document dated November 19, 2002 illustrating the technical design of claimed invention, which shows conception and reduction to practice prior to the reference date of October 3, 2003. The Declaration also includes, as Exhibit B, the Visual C++ source code for the user interface component of the claimed invention dated June 11, 2003, which shows due diligence from conception to the filing of the application. The Declaration also includes, as Exhibit C, a screen print of revision tracking software tracking when the last status change for artifacts of the claimed invention occurred, the screen print illustrating the last status change of the claimed invention occurring on June 11, 2003, which shows due diligence condition to subsequent reduction to practice and filing of the application.

The Declaration, together with Exhibits A, B and C, establishes that the subject matter set forth in claims 1-16, 23-46, and 48 of the present application was conceived and

reduced to practice before the reference date of October 3, 2003 of U.S. Patent No. 7,464,041, the Merkin reference, and that diligence was practiced to reduce the invention to practice by December 31, 2003. Accordingly, Applicants submit that the Declaration removes the Merkin reference from consideration. As the subject grounds of rejection of claims 1-7, 15-16, 23-36, and 43-46 include the Merkin reference, Applicants request withdrawal of the § 103(a) rejection based on the Merkin and Dvorak references.

C. Rejections Based on Merkin, Dvorak, and Kelly

Claims 8-14 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Merkin reference in view of the Dvorak reference in further view of U.S. Publication No. 2004/0243619 to Kelly, et al. (the “Kelly reference”). For the reasons set forth above, Applicants respectfully submit that the Declaration removes the Merkin reference from consideration. As the subject grounds of rejection of claims 8-14 include the Merkin reference, Applicants request withdrawal of the § 103(a) rejection based on the Merkin, Dvorak, and Kelly references.

D. Rejections Based on Merkin, Edelson, and Dvorak

Claims 37-42 and 48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Merkin reference in view of U.S. Patent No. 5,737,539 to Edelson (hereinafter the “Edelson reference”) in further view of the Dvorak reference. For the reasons set forth above, Applicants respectfully submit that the Declaration removes the Merkin reference from consideration. As the subject grounds of rejection of claims 37-42 and 48 include the Merkin reference, Applicants request withdrawal of the § 103(a) rejection based on the Merkin, Edelson, and Dvorak references.

### **CONCLUSION**

For at least the reasons stated above, claims 1-16, 23-46, and 48 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or [ajthompson@shb.com](mailto:ajthompson@shb.com) (such communication via email is herein expressly granted) – to resolve the same.

Submitted herewith is a Declaration under 37 C.F.R. § 1.131, and a Petition for a Three-Month Extension of Time, along with the appropriate fees. It is believed that no additional fee is due, however, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112, referencing attorney docket number CRNI.110337.

Respectfully submitted,

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